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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/530,386

04/27/2000

ANJA KLEIN

P00.0938

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21171 7590 02/06/2009

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EXAMINER

NGUYEN, TU X

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

02/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: ANJA KLEIN, MICHAEL FARBER and CHRISTIAN LUDERS

Application No. 09/530,386
Technology Center 2600

Mailed: February 5, 2009

Before TOI JOHNSON *Review Paralegal*
JOHNSON, *Review Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on July 14, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF,

Status of Claims

A review of the file finds that the status of the claims as provided in the Appeal Brief filed August 7, 2006 under the heading “Status of Claims” is unclear in accordance with 37 CFR 41.37(c)(1)(iii). Each claim on appeal must be identified. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

Summary of Claimed Subject Matter

Appellant filed an Appeal Brief dated August 7, 2006. The Appeal Brief is not in compliance with 37 CFR § 41.37(c) effective September 13, 2004.

According to 37 CFR § 41.37(c) (v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters.< While reference to page and line number of the specification **>requires< somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. >For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as

corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 7-9 of the Appeal Brief filed August 7, 2006, is deficient because it does not separately map independent claims 33-35 to the specification. Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

Argument

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed August 7, 2006, under the heading “Argument” have not been clearly provided. Each grounds of rejection must be treated under a separate heading in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number.

Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellant has not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

EXAMINER’S ANSWER, EVIDENCE RELIED UPON

Section §1207.02 of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007) states:

(A) CONTENT REQUIREMENTS FOR EXAMINER’S ANSWER. The examiner’s answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and in the case of nonpatent references, the relevant page or pages.

The Examiner’s Answer mailed September 7, 2007, is deficient because the “Evidence Relied Upon” section fails to include the references Gilhouse (US 5,485,486) and Bender (US 6,366,779) cited on pages 7-8 in the Examiner’s Answer’s grounds of rejection for claims 21 and 30 under 35 U.S.C § 103(a).

Appropriate correction is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed August 7, 2006 defective, as required by 37 CFR § 41.37(d);
- 2) notify Appellant to file a Supplemental Appeal Brief properly addressing the status of all appealed claims;
- 3) notify the Appellant to submit a Supplemental Appeal Brief which corrects the Appeal Brief's Summary of Claimed Subject Matter under 37 CFR §41.37(c)(1)(v);
- 4) notify Appellant to file a Supplemental Appeal Brief properly presenting the arguments for each grounds of rejection as required;
- 5) acknowledge and consider the Supplemental Appeal Brief submitted by Appellant to correct the Appeal Brief;
- 6) issue and mail a PTOL-90 citing the missing references listed under the Evidence Relied Upon section, paragraph (8); and
- 7) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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